

REMARKS

I. Status of Claims and Final Office Action Summary

Independent claims 1 and 14 are amended as set forth above, and the amendments find support in Applicants' specification at, for example, page 3, lines 20-23. New claim 15 is introduced and finds support in Applicants' specification at for example, page 7, lines 5-18. Claims 1-10 and 12-15 are pending and under current examination.

The Final Office Action:

(a) rejected claims 1-5, 7-10, and 12-14 under 35 U.S.C. § 103(a) as being unpatentable over EP 268 938 ("Kadokura") in view of U.S. Pat. App. Pub. No. 2002/0009564 ("Hall") and U.S. Patent No. 7,101,536 ("Mongiat") (Final Office Action at 2); and

(b) rejected claim 6 under 35 U.S.C. § 103(a) as being unpatentable over Kadokura and Mongiat, further in view of WO 01/43714 ("Reinehr") (Id. at 4).

II. Advisory Action mailed April 5, 2010

The Advisory Action indicated that the Amendment After Final filed on February 25, 2010, will not be entered because the claim amendments allegedly "are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal," and the Amendment does not place the application in condition for allowance. Advisory Action, Form PTOL-303. The Advisory Action also presented remarks in response to the Amendment After Final, to which Applicants do not accede. Id., Continuation Sheet, pages 2-3. Applicants discuss some of the Advisory Action's remarks below in section III of this paper.

III. Response to Final Office Action

A. Rejection of Claims 1-5, 7-10, and 12-14

Applicants respectfully traverse the rejection of claims 1-5, 7-10, and 12-14 under 35 U.S.C. § 103(a) as being unpatentable over Kadokura in view of Hall and Mongiat for the reasons of record and for at least the following additional reasons.

In making a rejection under 35 U.S.C. § 103, the Examiner “bears the initial burden of factually supporting any *prima facie* conclusion of obviousness. See M.P.E.P. § 2142. In its decision in *KSR Int’l Co. v. Teleflex Inc.*, 127 S. Ct. 1727, 82 U.S.P.Q. 2d 1385 (2007), the Supreme Court confirmed that the “framework for applying the statutory language of §103” was still based on its landmark decision in *Graham v. John Deere Co. of Kansas City*, 383 U.S. 1, 148 U.S.P.Q. 459 (1966). Under *Graham*, there are four factors for consideration when determining whether an invention is obvious:

- (1) the scope and content of the prior art;
- (2) the differences between the prior art and the claims at issue;
- (3) the level of ordinary skill in the art; and
- (4) secondary considerations.

383 U.S. at 17, 148 U.S.P.Q. at 467. However, the Court indicated that there is no necessary inconsistency between the idea underlying the teaching, suggestion, or motivation (“TSM”) test and the *Graham* analysis. *KSR*, 127 S. Ct. at 1741, 82 U.S.P.Q. 2d at 1389. As long as the TSM test is not applied as a “rigid and mandatory” formula, the test can provide “helpful insight” to an obviousness inquiry. *Id.*

The Advisory Action alleged that Kadokura teaches that “[i]t is still another object to provide cosmetics having incorporated therein the lamina and a good feeling in use in respect of spreading property and the like.” Advisory Action, Continuation Sheet,

page 2. See also Kadokura, page 2, lines 39-40. Applicants do not accede to this characterization of Kadokura, because Kadokura refers to incorporating its lamina into a cosmetic, and not incorporating an optically active substance into its matrix material. Thus, Kadokura does not disclose an optically active substance incorporated in its matrix material. Nor does Kadokura disclose or suggest “an optically active substance incorporated into ... porous silica particles,” as recited in claim 1.

Further, Kadokura does not disclose or suggest “[an] optically active substance is not present on an outer surface of ... porous silica particles,” as recited in amended independent claim 1. The optically active substance recited in claim 1 is incorporated into the particles and for at least this reason is not present on an outer surface of the particles. Thus, the optically active substance does not contact skin upon application. See Applicants’ specification, page 3, lines 20-23.

The Advisory Action argued that the proposed amendment to claims 1 and 14 in the February 25, 2010, Amendment After Final, “wherein, upon application of said cosmetic composition to skin, the optically active substance does not directly contact said skin,” is a result variable effect, suggesting that the Examiner is not giving the limitation patentable weight. Id. Applicants do not accede to this allegation and submit that the newly introduced recitation of claims 1 and 14, “[an] optically active substance is not present on an outer surface of ... porous silica particles,” is not a result variable effect and should be given patentable weight.

Hall does not overcome the deficiencies of Kadokura. Hall is directed to reducing friction between PET preforms and bottles, and discloses adding poly(methylsilsequioxane) to PET to “reduce surface friction without producing

objectionable levels of haze” in the PET. Hall, Abstract and paragraph [0016]. Hall does not disclose or suggest, at least, that “[an] optically active substance is not present on an outer surface of ... porous silica particles,” as recited in amended independent claim 1.

Mongiat also does not overcome the deficiencies of Kadokura. Mongiat discloses UV-protection formulations (Mongiat, Abstract) but does not disclose or suggest, at least, that “[an] optically active substance is not present on an outer surface of ... porous silica particles,” as recited in amended independent claim 1.

For at least these reasons, independent claim 1, as proposed to be amended, should be allowable over Kadokura, Hall, and Mongiat. Independent claim 14 differs in scope from claim 1 but is also amended to recite that “[an] optically active substance is not present on an outer surface of ... porous silica particles.” Amended independent claim 14 should be allowable at least for reasons similar to those presented regarding claim 1. Claims 2-5, 7-10, 12, and 13 should be allowable at least due to their dependence from claim 1. Applicants, therefore, respectfully request reconsideration and withdrawal of the rejection of claims 1-5, 7-10, and 12-14.

B. Rejection of Claim 6

Applicants respectfully traverse the rejection of claim 6 under 35 U.S.C. § 103(a) as being unpatentable over Kadokura and Mongiat, further in view of Reinehr for the reasons of record and for at least the following additional reasons. As explained above, independent claim 1, as proposed to be amended, should be allowable over Kadokura and Mongiat.

Reinehr is cited for its alleged disclosure of the use of fluorescent substances (Final Office Action at 5), but without acceding to this characterization of Reinehr, Applicants submit that Reinehr does not overcome the deficiencies of Kadokura and Mongiat. This is at least because Reinehr does not disclose or suggest, at least, that “[an] optically active substance is not present on an outer surface of ... porous silica particles,” as recited in amended independent claim 1.

For at least these reasons, amended independent claim 1, and claim 6 which depends from claim 1, should be allowable over Kadokura, Mongiat, and Reinehr. Applicants, therefore, respectfully request reconsideration and withdrawal of the rejection.

IV. New Claim 15

As explained above, amended independent claim 1 should be allowable. New claim 15 should also be allowable, at least due to its dependence from claim 1.

V. Conclusion

In view of the foregoing amendments and remarks, Applicants respectfully request reconsideration of the present application and the timely allowance of the pending claims.

The Examiner may contact the undersigned with any questions or comments.

Please grant any extensions of time required to enter this response and charge any additional required fees to our Deposit Account No. 06-0916.

Respectfully submitted,

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